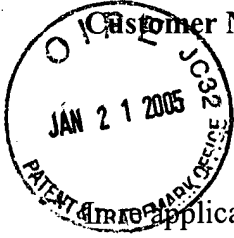


DOCKET NO. WILK03-00004

PATENT



Customer No. 23990

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: : Angela Marcela Wilkinson
Serial No. : 10/055,358
Filed : January 22, 2002
For : PLACEMAT WITH CONFORMAL INTEGRAL DRINK
COASTER
Group No. : 1772
Examiner : A.S. Thomas

MAIL STOP APPEAL BRIEFS – PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S BRIEF ON APPEAL

This Brief is submitted in triplicate on behalf of Appellant for the application identified above. A check is enclosed for the \$250.00 fee for filing a Brief on Appeal. Please charge any additional necessary fees to Deposit Account No. 50-0208.

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REAL PARTY IN INTEREST

The real party in interest for this appeal is the applicant.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to the present application which are currently pending.

STATUS OF CLAIMS

Claims 1-2, 4-5 and 9-20 are pending in the present application. Claims 3 and 6-8 were canceled. Claims 1-2, 4-5, 9-14 and 16-20 were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. D181,058 to *Kaye*. Claims 1-2, 4-5, 9-15 and 16-20 were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. D266,045 to *Kamel et al.* Claims 1-2, 4-5, 10, 12, 14 and 16 were rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. D139,954 to *Krass*. The rejection of pending claims 1-2, 4-5 and 9-20 is appealed.

STATUS OF AMENDMENTS

No amendments to the claims were submitted in response to the final Office Action mailed May 14, 2004.

SUMMARY OF CLAIMED SUBJECT MATTER

Placemats, commonly employed to protect table clothes or other underlying surfaces from food spills during dining (particularly by children), are generally sized for a place setting of a plate and utensils (fork, spoon and/or knife) without regard for a beverage container to be employed by

the diner, although condensation or beverage spills may similarly damage the underlying surface. Specification, page 2, lines 3–16. Simply making the overall size of the placemat larger may result in difficulty fitting the placement in a small space available as a dining surface. Specification, page 2, line 17 through page 3, line 2.

The present invention is a placemat having an ordinary sized body or major portion, approximately 12–14 inches by approximately 18–24 inches, sufficient to underlie a typical place setting of a plate, utensils and perhaps a napkin without extending significantly beyond the region occupied by such items or leaving sufficient room for a beverage container. Specification, page 9, lines 4–17 and page 11, lines 2–5. Therefore, integrally formed with the body or major portion is a coaster extension or minor portion, projecting from a periphery of the body or major portion and sized to accommodate a typical beverage container (about 3-4 inches in both dimensions). Specification, page 9, lines 18 through page 10, line 11.

The placemat is preferably made from cloth, laminate, cork, rubber, neoprene or other plastics on which printed subject matter may be readily affixed, so that a consistent theme between the subject matter appearing on the body or major portion and the subject matter depicted on the coaster extension or minor portion. Specification, page 8, line 11 through page 9, line 3 and page 10, line 21 through page 13, line 8.

The coaster extension or minor portion preferably extends from the upper-right periphery of the body or major portion, for the convenience of predominantly right-handed diners. However, in

one embodiment, the placemat is reversible (adapted for use regardless of which side is up) and may be flipped over for the convenience of left-handed diners. Specification, page 10, lines 2–11 and page 13, lines 9–18. For such reversible embodiments, the graphic content is preferably provided in mirror image on both sides.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1–2, 4–5, 9–14 and 16–20 were rejected under 35 U.S.C. § 103 as being obvious over *Kaye*. Claims 1–2, 4–5, 9–15 and 16–20 were rejected under 35 U.S.C. § 103 as being obvious over *Kamel et al.* Claims 1–2, 4–5, 10, 12, 14 and 16 were rejected under 35 U.S.C. § 103 as being obvious over *Krass*. These rejections are appealed.

ARGUMENT

Claims 1–2, 4–5, 10, 12, 14, 16 and 20 were all rejected as being obvious over either of *Kaye* or *Kamel et al.*, and claims 1–2, 4–5, 10, 12, 14 and 16 were also all rejected as being obvious over *Krass*.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-128 (8th ed. rev. 2 May 2004). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Independent claims 1, 10 and 20 each recite specific dimensional limitations for both the body and coaster extension portions of the placemat, and limitations regarding the material of construction for the placemat, that are not shown or suggested by the cited references. Such a feature is not found in any of the cited references, none of which provide any dimensional information or regarding the subject matter depicted or information regarding the materials of construction thereof.

The Office Action infers that the dimensional limitations are satisfied by the intended use of the articles depicted in the cited references – as placemats. However, even accepting that argument with respect to the body or major portion, neither of *Kaye* or *Kamel et al* teach or suggest that the “extension” (the cat's head in *Kaye* and the “bread,” “butter” and “silver” regions in *Kamel et al*) are intended to be used as a coaster. Accordingly, the inference regarding the size of such regions is not supported by the cited references. *Krass*, while depicting a region purportedly for use as a coaster, depicts such region as having an elevated ring thereon, presumably for retaining the beverage container, and a peripheral region extending significantly outward around that ring. According, the “coaster” region including that ring must be inferred to be substantially larger than

the area required to accommodate a typical beverage container such as a glass or mug (the recited dimensional limitation of 3–4 inches, as disclosed in the specification), and the inference that the dimensional limitation is satisfied is again not supported by the cited reference.

In addition, the recited dimensional limitations for the body or major portion are those disclosed in the specification as being suitable to underlie a typical place setting without being substantially larger (a limitation explicitly recited in claim 2). Specification, page 11, lines 4–5. None of the references containing any suggestion of being so sized, rather than being (either deliberately or unintentionally) over-sized. Accordingly, none of the cited references provide any basis for believing that the recited dimensional limitations are satisfied.

With respect to the recited materials for construction, the Office Action merely asserts without any support that such materials are well-known in the relevant art, and therefore the placemats depicted in the cited references may be suitably constructed of such materials. Such speculation is entirely unsupported by the record.

Claims 11–13 and 20 each recite, explicitly or inherently, that the placemat is reversible, suitable for use regardless of which surface is up. Such a feature is not disclosed by the cited references. The Office Action does not address this feature.

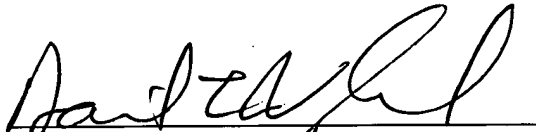
CONCLUSION

The cited references fail to teach or suggest every feature recited in the claims. Therefore, the rejection under 35 U.S.C. § 103 is improper. Applicant respectfully requests that the Board of Appeals reverse the decision of the Examiner below rejecting pending claims 1-2, 4-5 and 9-20 in this application.

Respectfully submitted,

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Date: 1-13-05


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CLAIMS APPENDIX

1 1. A placemat, comprising:
2 a placemat body including:
3 a major portion sized to completely underlie a place setting including a plate and
4 silverware, the major portion having a height of approximately 12–14 inches and a width of
5 approximately 18–24 inches; and
6 a coaster extension integrally formed with and projecting from a peripheral edge of
7 the major portion and sized to completely underlie a beverage container, the coaster
8 extension having a width of approximately 3–4 inches,
9 wherein the placemat body is formed from a material selected from cloth, laminate, cork,
10 rubber, neoprene and other plastics.

1 2. The placemat as set forth in Claim 1, wherein the size of the major portion is not substantially
2 larger than necessary to completely underlie a place setting.

Claim 3. (Canceled).

1 4. The placemat as set forth in Claim 1, wherein a shape of the coaster extension is consistent
2 with a theme conveyed by a shape of the major portion.

1 5. The placemat as set forth in Claim 1, wherein any graphic content on the coaster extension
2 is consistent with a theme conveyed by graphic content on the major portion.

Claims 6–8 (Canceled).

1 9. The placemat as set forth in Claim 1, wherein the minor portion projects from an upper, right
2 periphery of the major portion.

1 10. A placemat, comprising:

2 a major body portion sized to completely underlie a place setting, the place setting consisting
3 of a plate and utensils, the major portion having a height of approximately 12–14 inches and a width
4 of approximately 18–24 inches; and

5 a coaster extension projecting from a peripheral edge of the major body portion and sized to
6 completely underlie a beverage container, the coaster extension having a width of approximately 3–4
7 inches,

8 wherein the major body portion and the coaster extension are integrally formed, and

9 wherein the major body portion and the coaster extension are formed from a material selected
10 from cloth, laminate, cork, rubber, neoprene and other plastics.

1 11. The placemat according to claim 10, wherein the placemat is reversible and may be employed
2 while resting on a first surface or while resting a second surface opposite the first surface.

1 12. The placemat according to claim 10, wherein the coaster extension projects from an upper,
2 right or upper right peripheral edge of the major body portion when the placemat rests on a first
3 surface and from an upper, left or upper left peripheral edge of the major body portion when the
4 placemat rests on a second surface opposite the first surface.

1 13. The placemat according to claim 10, wherein the placemat is reversible, and wherein,
2 when the placemat rests on a first surface, the coaster extension projects from position
3 between a center of an upper peripheral edge of the major body portion and a center of a right
4 peripheral edge of the major body portion, and
5 when the placemat rests on a second surface opposite the first surface, the coaster extension
6 projects from position between the center of the upper peripheral edge and a center of a left
7 peripheral edge of the major body portion.

1 14. The placemat according to claim 10, wherein the major body portion has a first shape and
2 the coaster extension has a second shape.

1 15. The placemat according to claim 14, wherein the second shape is identical to but smaller than
2 the first shape.

1 16. The placemat according to claim 14, wherein the second shape is different from but
2 complementary to the first shape.

1 17. The placemat according to claim 14, wherein the first and second shapes are common
2 geometric shapes.

1 18. The placemat according to claim 14, wherein the first shape represents a first object and the
2 second shape represents a second object different from the first shape.

1 19. The placemat according to claim 14, wherein the first and second shapes are common
2 geometric shapes.

1 20. A reversible placemat, comprising:

2 a body adapted for use regardless of whether the placemat rests on either a first surface or a
3 second surface opposite the first surface, the body including:

4 a first portion having a first shape and sized to completely underlie a place setting,
5 the place setting consisting of a plate and utensils, the first portion having a height of
6 approximately 12–14 inches and a width of approximately 18–24 inches; and

7 a second portion having a second shape, projecting from a peripheral edge of the first
8 portion and sized to completely underlie a beverage container, the coaster extension having
9 a width of approximately 3–4 inches,

10 wherein the second portion projects from an upper right peripheral edge of the first portion
11 when the placemat rests on the first surface and from an upper left peripheral edge of the first portion
12 when the placemat rests on the second surface, and

13 wherein the body is formed from a material selected from cloth, laminate, cork, rubber,
14 neoprene and other plastics.

EVIDENCE APPENDIX

Not applicable.

RELATED PROCEEDINGS APPENDIX

Not applicable.